

REMARKS

Entry of this Amendment is proper because it narrows the issues on appeal and does not require further search by the Examiner.

Claims 1-20 are all the claims presently pending in the application. Claims 2, 3, 5 and 15 have been amended to more clearly define the invention. Claims 1, 4, 7 and 15 are independent.

It is noted that the claim amendments are made only for more particularly pointing out the invention, and not for distinguishing the invention over the prior art, narrowing the claims or for any statutory requirements of patentability. Further, Applicant specifically states that no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

Claims 1-3, and 7-8 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Swartz, et al. (USPN 6,330,244), and further in view of Sashihara (USPN 6,434,405). Claims 4-6 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Sashihara, and further in view of Swartz, et al. Claims 15-20 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Alperovich (USPN 6,317,609), further in view of Swartz, et al., and further in view of Sashihara. Claims 9-14 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Sashihara, further in view of Swartz, et al., and further in view of Alperovich.

These rejections are respectfully traversed in the following discussion.

I. THE CLAIMED INVENTION

The claimed invention as defined, for example, in claim 1, is directed to a wireless telephone that receives data of at least one of an image and characters through a transmitting provider. The wireless telephone includes a detector for detecting the data received from the transmitting provider, a designating device for designating the data for reception by the wireless telephone from the transmitting provider and for selectively designating an apparatus to which the received data is to be transmitted, and a wireless communicating device that communicates with the apparatus without the transmitting provider and transmits the data to the apparatus designated by the designating device.

Conventional telephones may receive data from a transmitting provider. However, such conventional telephones cannot wirelessly transmit data received by the telephone to an apparatus without using the transmitting provider.

The claimed invention, on the other hand, includes a wireless communicating device that communicates with the apparatus without the transmitting provider. Thus, unlike conventional telephones, the inventive telephone can wirelessly transmit data received by the telephone to an apparatus without using the transmitting provider. This allows for high-speed communication between the telephone and the apparatus, so that data (e.g., large image files which are too large to be stored or displayed by said telephone) can be quickly transmitted to the apparatus and stored, printed, etc.

II. THE PRIOR ART REFERENCES

A. The Swartz and Sashihara References

The Examiner alleges that Swartz would have been modified by the teachings of Sashihara to form the claimed invention of claims 1-3 and 7-8, and that Sashihara would have been modified by the teachings of Swartz to form the claimed invention of claims 4-6. Applicant submits, however, that these references would not have been combined and even if combined, the combination would not teach or suggest each and every element of the claimed invention.

Swartz discloses a wireless local area network for digital radio communication between remote devices and a private branch exchange (PBX) telephone system. Further, a wireless phone is provided for voice and data communication through the PBX or a central office (CO) telephone line with remote locations or the Internet using digital data packets and standard Internet Protocol (Schwartz at Abstract).

Sashihara, on the other hand, discloses a transmitting and receiving card selectively attached to a portable phone or an information terminal. When the card is attached to the portable phone, the card as the information terminal so as to retrieve information such as e-mail stored in a server via the portable phone, and to transmit information stored in advance in the card to such a server according to a request (Sashihara at Abstract).

However, Applicant submits that these references would not have been combined as alleged by the Examiner. Indeed, these references are directed to different problems and solutions. Specifically, Schwartz is intended to provide an improved system for connecting a wireless local area network (LAN) or wide area network (WAN) to a private branch exchange (PBX) (Schwartz at col. 1, lines 49-51), whereas Sashihari is merely intended to allow a portable phone to mail server without using a cable. Therefore, these references are completely unrelated, and no person of ordinary skill in the art would have considered combining these disparate references, absent impermissible hindsight.

Further, Applicant submits that the Examiner can point to no motivation or suggestion in the references to urge the combination as alleged by the Examiner. Indeed, the Examiner merely states that it would have been obvious to combine these references to avoid the inconvenience of using a cable/line connection. However, the Examiner's stated motivation to combine is completely unrelated to at least one objective of the claimed invention (e.g., transmitting data to an apparatus without using a transmitting provider) and, therefore, is insufficient to support the alleged combination.

Moreover, neither of these references teaches or suggests "*a wireless communicating device that communicates with the apparatus without the transmitting provider and transmits the data to the apparatus designated by said designating device*" as recited, for example, in claim 1. As noted above, conventional telephones may receive data from a transmitting provider. However, such conventional telephones cannot wirelessly transmit data received by the telephone to an apparatus without using the transmitting provider.

The claimed invention, on the other hand, includes a wireless communicating device that communicates with the apparatus without the transmitting provider and transmits the data to the apparatus designated by said designating device (Application at Figure 2; page 4, lines 6-11). This allows for high-speed communication between the telephone and the apparatus, so that data (e.g., large image files which are too large to be stored or displayed by said telephone) can be quickly transmitted to the apparatus and stored, printed, etc. (Application at page 6, lines 19-26).

Clearly, the cited references do not teach or suggest these novel features. Indeed, neither of these references even discuss at least one problem (e.g., transmitting data to an

apparatus without a transmitting provider) which the claimed invention is intended to address.

Moreover, the Examiner expressly concedes that Sashihara does not teach or suggest these features, stating “Sashihara didn’t further disclose: ... transmitting the data to the designated apparatus with a wireless communicating device that communicates with the apparatus without the transmitting provider” (Office Action at page 5).

Further, contrary to the Examiner’s allegations, Applicant respectfully submits that these novel features are not taught or suggested by Schwartz. As noted above, Schwartz merely discloses a wireless local area network for digital radio communication between remote devices and a private branch exchange (PBX) telephone system. Nowhere does Schwartz disclose a mobile unit which wirelessly communicates with an apparatus without a transmitting provider.

Indeed, Schwartz may disclose that the mobile unit is wirelessly connected to an access point (AP). However, that access point is connected by wire to an Ethernet which is connected to the private branch exchange. This is clearly shown in nearly every figure in Schwartz (e.g., see Schwartz at Figure 1).

The Examiner alleges that the host interface unit (HIU) 14 is the equivalent of a transmitting provider. However, referring to the exemplary aspect illustrated in Figure 3, the Application explains that a transmitting provider may be used to transmit data, for example from a server 44 to the inventive telephone.

Schwartz discloses that a server 42 transmits data to the private branch exchange 36, which then transmits the data to the mobile unit 12 (e.g., through the host interface unit (HIU) 14 (Schwartz at Figure 1). Indeed, this is a very fundamental concept in Schwartz. Applicant notes, for example, that Schwartz states that his system “permits the MU to access the voice mail features of the PBX and for the PBX to access data storage devices on the wireless LAN” (Schwartz at col. 2, lines 24-28).

Moreover, Applicant notes that definition of “mobile unit” in Schwartz clearly contradicts the Examiner’s characterization of the system. That is, Schwartz defines the mobile unit as “any portable or stationary device that transmits data to an AP by digital radio communication”. In other words, the mobile unit requires the AP to communicate with the

rest of the system in Schwartz. The AP is connected by wire to the server 44 through the private branch exchange 36.

Thus, the private branch exchange 36 is clearly a “transmitting provider”. Therefore, contrary to the Examiner’s allegations, Schwartz does not teach or suggest a wireless communicating device that communicates with the apparatus without the transmitting provider. Therefore, Schwartz clearly does not make up for the deficiencies of Sashihara.

Therefore, Applicant respectfully submits that these references would not have been combined and even if combined, the combination would not teach or suggest each and every element of the claimed invention. Therefore, the Examiner is respectfully requested to withdraw this rejection.

B. The Alperovich Reference

The Examiner alleges that Alperovich would have been modified by the teachings of Schwartz, and that the Alperovich/Schwartz combination would have been further modified by the teachings of Sashihara to form the claimed invention of claims 15-20. The Examiner also alleges that Sashihara would have been modified by the teachings of Schwartz, and that the Sashihara/Schwartz combination would have been further modified by the teachings of Alperovich to form the claimed invention of claims 9-14. Applicant submits, however, that these references would not have been combined and even if combined, the combination would not teach or suggest each and every element of the claimed method OR invention.

Alperovich discloses a telecommunications system for transmitting digital images produced by a digital camera attached to or integrated with a mobile station (MS) from the MS to a receiving terminal through the Internet (Alperovich at Abstract).

However, Applicant submits that Alperovich would not have been combined with Schwartz and Sashihara as alleged by the Examiner. Indeed, these references are directed to different problems and solutions. Specifically, Alperovich is directed to a system for transmitting digital images which allegedly improves the quality of a digital image by reducing the load on the cellular and fixed networks (Alperovich at col. 3, lines 49-53). This is completely unrelated to the systems of Schwartz and Sashihara. Therefore, no person of

ordinary skill in the art would have considered combining these disparate references, absent impermissible hindsight.

Further, Applicant submits that the Examiner can point to no motivation or suggestion in the references to urge the combination as alleged by the Examiner. Indeed, the Examiner merely states that it would have been obvious to combine these references to “transfer the image/data file to another peripheral device when the wireless phone doesn’t have enough capacity to load the entire sent data”. However, Alperovich is intended to reduce the load on a network, and does not address a capacity of a wireless telephone. Therefore, the Examiner’s allegations are insufficient to support the alleged combination.

Moreover, like Schwartz and Sashihara, Alperovich does not teach or suggest “*a wireless communicating device that communicates with the apparatus without the transmitting provider and transmits the data to the apparatus designated by said designating device*” as recited, for example, in claim 7 (from which claim 9 depends) and similarly recited in claim 15. As noted above, this allows for high-speed communication between the telephone and the apparatus, so that data (e.g., large image files which are too large to be stored or displayed by said telephone) can be quickly transmitted to the apparatus and stored, printed, etc. (Application at page 6, lines 19-26).

Clearly, Alperovich does not teach or suggest these novel features. Indeed, the Examiner expressly concedes that Alperovich does not teach or suggest these features, stating “Alperovich didn’t further disclose: ... transmitting the designated data to the designated apparatus through a wireless connection device installed on the second wireless telephone”. Therefore, Alperovich clearly does not make up for the deficiencies of Schwartz and Sashihara.

Therefore, Applicant respectfully submits that these references would not have been combined and even if combined, the combination would not teach or suggest each and every element of the claimed invention. Therefore, the Examiner is respectfully requested to withdraw this rejection.

III. FORMAL MATTERS AND CONCLUSION

In view of the foregoing, Applicant submits that claims 1-20, all the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Date: 8/22/09

Respectfully Submitted,



Phillip E. Miller
Registration No. 46,060

McGinn & Gibb, PLLC
8321 Old Courthouse Road, Suite 200
Vienna, VA 22182-3817
(703) 761-4100
Customer No. 21254